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Thomas A O'Rourke
Bodner & O'Rourke, LLP
425 Broadhollow Road
Melville, NY 11747

EXAMINER

WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/943,372

Applicant(s)

SOTT, CHERYL

Examiner

Shengjun Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 38-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 38-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections 35 U.S.C. 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 38-56 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for particular personal preferences which could be directly linked to particular essential oil, does not reasonably provide enablement for the general “processing” data, “determining” or selecting essential oil based on the data and the “conditions of profile”. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. Note the “processing” and calculation of “profile” may encompass anything that might be relevant to human. The instant claims are drawn to a method comprising steps of: a) gathering data of an individual; b) “processing the data, and preparing a “profile;” c) determining from said profile whether one or more essential oil may be excluded from an essential oil; d) co-relating the profile to particular essential oils; and selecting essential oil based on the results; ...etc. The specification or the claims does not provide sufficient guidance, direction and working example to enable a skilled artisan to fully understand and perform the “processing,” “determining,” and the “conditions of profile” herein, and to perform the claimed invention without undue experimentation.

2. The instant specification fails to provide information that would allow the skilled artisan to practice the instant invention without undue experimentation. Attention is directed to In re

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Wands, 8 USPQ 2d 1400 (CAFC 1988) at 1404 where the court set forth the eight factor to consider when assessing if a disclosure would have required undue experimentation. Citing Ex parte Forman, 230 USPQ 546 (BdApl 1986) at 547 the court recited eight factors:

- 1) the quantity of experimentation necessary,
- 2) the amount of direction or guidance provided,
- 3) the presence of absence of working examples,
- 4) the nature of the invention,
- 5) the state of the prior art,
- 6) the relative skill of those in the art,
- 7) the predictability of the art, and
- 8) the breadth of the claims.

The instant claims are drawn to a method comprising steps of: a) processing data of an individual; and preparing a "profile;" b) determining from said profile whether one or more essential oil may be excluded from an essential oil; c) co-relating the profile to particular essential oils; and selecting essential oil based on the results; ...etc. The claims read on any method that may be used for selecting essential oil for human application. However, the specification or the claims fails to provide sufficient guidance, direction and working examples with respect to how to carry out such steps. More specifically, the specification of the claims does not provide sufficient guidance, direction, and working examples for the steps comprised in claimed method. For example, there is no clear guidance or direction as to how to do the analysis, determination, and correlating the obtained "conditions of profile" to essential oil. In fact the application does not define what is the "profile" mentioned in the application. See, pages

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13. One of ordinary skill in the art would have not been able to carry out the steps of a) performing an analysis of an individual; b) calculating a value from the analysis; c) co-relating the conditions of profile to particular essential oils; and selecting essential oil based on the results. Note the Applicants fail to provide information allowing skilled artisan to ascertain these steps without undue experimentation. One of skilled artisan would have not known how to “processing data”, “determining” or “selecting” as herein required. For example, the application never teaches how to select essential oils based on health, emotional or spiritual conditions.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 and 38-56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for reasons set forth in the prior office action.

5. Claim 1 recites “profile,” however, the specification or the claims fails to provide a definition for the “profile”. The claims are indefinite as to the “profile” encompassed thereby.

Claim Rejections 35 U.S.C. 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 1 and 38-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rigg et al. (US 5,622,692), in view of Meador et al. (US 5,031,764)

8. The claimed invention has been broadly construed as a method of formulating customized cosmetic product based on the information from the customer. Rigg et al. teaches a method of making customized cosmetic product based on the information obtained from customer. The information is stored and processed by a PC. See, particularly, the abstract, the drawing, and the claims. Rigg particularly suggest to employ computer for processing the data received. See, particularly, figure 1, and column 2, lines 3-67.

9. Rigg does not teach expressly to customize the ingredient of essential oils, or the particular steps herein.

10. However, Meador teaches that method of customizing fragrance based on customer's preference is known in the art. See, particularly, columns 1-3.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ the method of Rigg for customizing essential oil composition in a cosmetic product based on customer's preference.

A person of ordinary skill in the art would have been motivated to employ the method of Rigg for customizing essential oil composition in a cosmetic product based on customer's preference because such method would have provide customized product. One of ordinary skill in the art would have been reasonably expected to be able to make a customized essential oil composition since such method is known in the art. See, In re Boesch and Slaney (CCPA) 204 USPQ 215. Furthermore. Employment of a customized fragrance composition in various well-known cosmetic forms recited herein is considered within the skill of artisan and is obvious. Further, the

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intended use of a composition, i.e., “for aromatherapy” is not seen to further limit the claimed composition. Finally, an individual’s choice of essential oil would have been certainly affected by the individual’s emotion, spirit and/or health. Claim 56 requires the computer have two sub data bases, one for the ingredients, and the other for personal information. To store two kinds of information separately would have been obvious to one of ordinary skill in the art.

Response to the Arguments

Applicants’ amendments and remarks submitted June 9, 2006 have been fully considered, but are not persuasive and the examiner maintains his position as discussed in the prior office action.

Regarding the rejections under 35 U.S.C. 112, applicant argues

“It is *commonly known* in the aromatherapy industry that certain essential oils have ideal therapeutic qualities. Basil oil for instance has known anti-inflammatory, antiseptic, antispasmodic and aphrodisiac properties associated with it. It is also commonly known in the aromatherapy industry that an aroma therapist is one who practices the art of aromatherapy. Let's say one were to go to an aroma therapist complaining of a burn or stagnant sex life, the aroma therapist might prescribe a bath infused with basil oil, or a basil oil massage. The point being one would expect an aroma therapist to know how to determine and select the appropriate essential oil, just as one would expect a doctor to know how to determine and select certain medications, and/or therapies after an office visit.

It is therefore the applicant's position that one who practices aromatherapy, i.e. an aroma therapist, should by all accounts be familiar with the different therapeutic properties associated with the many different essential oils, and as such should not need further teaching on how to select the appropriate oils.” (page 8 of the response, emphasis added).

Applicant essentially argues that all the information that is not in the specification, but required for practicing the claimed invention is well known in the art. Such arguments are not persuasive. First, it is noted that the arguments lack any factual support. Applicants provide no evidence that one skilled in the art would know how to “processing data”, “determining” or “selecting” as herein required. Further, aromatherapy, as an alternative method, lacks a standard

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system. Artisans from different backgrounds, may have different view of the choice of essential oil based the individual's emotion, spirit and/or health.

Applicants also contend that one of skilled artisan would be able to practice the claimed invention by following the tables (figures). It is noted that tables, (as well as the application as whole), uses a lot of undefined, absurd and/or mystery phrase, which one of skilled artisan would not fully understand it. Following are few examples, "universe modification process," "Chakra process" (figure 1), "exclusionary analysis," test for exclusionary conditions," "modified Universe" (figure 3), "primary essential oil family set," (figure 5) etc. All those undefined terms have to be clearly defined so that one of skilled artisan would understand what the application is talking about.

As to the US patent cited by the applicants, it is noted that an issued US patent is a property, not a preset law. The examiner cannot, and will not make any comment on an issued US patent. Further, the issue herein is the content of the application, not the format of the claims.

11. With regard to the rejections under 35 U.S.C. 103, note, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Further, question under 35 U.S.C. 103 is not merely what reference expressly teach, but what they would have suggested to one of ordinary skill in the art at the time the invention was made; all disclosures of prior art, including unpreferred embodiments, must considered. In re Lamberti and Konort (CCPA), 192 USPQ 278. Considering Rigg reference and Meador

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reference as a whole, providing an individual an aromatic composition based on the individual's personal conditions and preference would have been obvious to one of ordinary skill in the art.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SHENGJUN WANG
PRIMARY EXAMINER
Shengjun Wang
Primary Examiner
Art Unit 1617